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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,227	09/29/2000	Scott R. Sargent	10022/035	9555

33391 7590 03/08/2005

BRINKS HOFER GILSON & LIONE
ONE INDIANA SQUARE, SUITE 1600
INDIANAPOLIS, IN 46204

EXAMINER

KANG, PAUL H

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/676,227

Applicant(s)

SARGENT ET AL.

Examiner

Paul H Kang

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) a set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached comments.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). See attached comments
13. ☐ Other: _____.

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Continuation of 11: does NOT place the application in condition for allowance because:

the request for reconsideration is not deemed to be persuasive. The applicants argued in substance that the Bowman-Amuah reference cannot be used in a 35 U.S.C. §102(e) rejection since declarations of Inventors Sargent and Taylor filed August 4, 2004 under 37 C.F.R. §1.132 established that the subject matter included in Bowman-Amuah is not the work of another but is the applicants' own work

“When the unclaimed subject matter of a patent, application publication, or other publication is applicant's own invention, a rejection, which is not a statutory bar, on that patent or publication may be removed by submission of **evidence** establishing the fact that the patentee, applicant of the published application, or author derived his or her knowledge of the relevant subject matter from applicant. Moreover applicant must further show that he or she made the invention upon which the relevant disclosure in the patent, application publication, or other publication is based. In re Mathews, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969); In re Facius, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969).” (Emphasis Added) MPEP 715.01(c).

The declarations filed by the Inventors in the instant application failed to submit evidence which Boman-Amuah derived the relevant subject matter from the applicants. The evidence presented in the declaration merely establish the existence of subject matter (Chapter 3 of the book “Netcentric and Client/Server Computing,” by Goodyear et al..) alleged to have been the source from which Boman-Amuah derived the disclosed material.

Additionally, as previously noted in the Final Rejection, the evidence submitted by applicants in the declaration (namely a table mapping ‘382 Patent Figure Nos. to Chapter 3 of

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Goodyear) is insufficient. Applicants must establish all relevant portions relied upon by the examiner in the rejection under 35 U.S.C. §102(e) was Inventors' own work, derived by Bowman-Amuah. Mapping various figures of the '382 patent to selected pages of Chapter 3 of Goodyear is insufficient.

Finally, applicants have not overcome the nonstatutory double patenting rejection of claims 4, 6-7, 13-30, 39-41 and 43. Applicants assert co-pending applications 09/677,136, 09/675,913, and 09/677,065 have been abandoned, rendering the double patenting rejections moot. However, the status of the above applications does not indicate the applications as being abandoned. Further, applicants' bald assertion of patentable distinction between claims 4, 6-7, 13-30, 39-41 and 43 and corresponding claims of cited applications is not sufficient. Applicants must point out with specificity how the claim amendments in the co-pending applications render the present invention patentably distinct.

Accordingly, the Final Rejection of December 16, 2004 is maintained.

Information Disclosure Statement

Information disclosure statements filed previously are attached hereto:

- 1) Filed February 16, 2005 as Appendix A – part 1, originally filed August 6, 2004.
- 2) Filed February 16, 2005 as Appendix A – part 2, originally filed August 6, 2004.
- 3) Filed February 16, 2005 as Appendix B, originally filed August 6, 2004.
- 4) Filed February 16, 2005 as Appendix C, originally filed August 30, 2004.
- 5) Filed February 16, 2005 as Appendix D, originally filed December 20, 2004.
- 6) Filed December 20, 2004 (1 page).

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7) Filed August 6, 2004 (2 pages).

8) Filed August 6, 2004 (3 pages).



PAUL H. KANG
PRIMARY PATENT EXAMINER